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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,805	03/09/2000	DAVID LEIGH DONOHO	UNIV0001D6	2848

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/521,805

Applicant(s)

DONOHO ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

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### DETAILED ACTION

1. This communication is in response to the Amendment filed on November 19, 2002. Claims 1-38 are pending.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 15, 20, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164) and further in view Pant et al (6,012,053).

(A) As per claim 1, Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (Col.1, lines 18-42);

wherein said advice consumer is advised of said information if said information meets certain predetermined relevance criteria (Col.3, lines 1-10);

a reader resident with said advice consumer that determines relevance of said broadcast information; and

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wherein said advice provider offers highly targeted advice without compromising individual privacy (Col.5, lines 21-52). Herz does not explicitly disclose a system including an advice consumer for gathering broadcast information from a communications medium, a communications system. However, this feature is known in the art, as evidenced by Basche. In particular, Basche teaches a system including an advice consumer for gathering broadcast information from a communications medium, a communications system (See Basche Col.1, lines 6-32; Col.2, lines 25-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Basche within the system for customized electronic identification of desirable objects of Herz with the motivation of distributing information to a targeted audience over a computer network in a way that does not require members of that audience to use any search engine (See Basche Col.1, lines 57-60).

The combination of Herz and Basche discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (See Herz, Col.1, lines 18-42). The combination of Herz and Basche does not explicitly disclose a reader resident with said advice consumer that determines relevance of said broadcast information.

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However, this feature is known in the art, as evidenced by Pant. In particular, Pant suggests a reader resident with said advice consumer that determines relevance of said broadcast information (See Pant, Col.2, lines 25-43; Col.13, lines 41-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Pant within the collective teachings of Herz and Basche with the motivation of providing a server computer and the process performed by the server computer to receive and process a query and relevance factors from a client computer to produce relevancy ranked search results (See Pant, Col.2, lines 25-54).

(B) As per claim 15, Herz discloses a method for remotely and anonymously inspecting one or more communicating devices for information of interest to information consumers (Col.33, lines 3-59; Col. 34, lines 47-67 to Col.35, line 45) said method comprising the steps of:

providing a third party consumer database inspector which is installed on a third party computer for determining if said information is relevant to any individuals in a consumer database (Col.1, lines 18-42);

using relevance evaluation to generate queries to said third party consumer database inspector (Col.30, lines 3-67 to Col.31, line 35); and

providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (Col.30, lines 3-67 to Col.31, line 35).

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Herz does not explicitly disclose said third party computer gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers. However, this feature is known as evidenced by Basche. In particular, Basche teaches said third party computer gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers (See Basche Col.1, lines 6-32).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Basche within the system for customized electronic identification of desirable objects of Herz with the motivation of distributing information to a targeted audience over a computer network in a way that does not require members of that audience to use any search engine (See Basche Col.1, lines 57-60).

(C) Claim 20 differs from claims 1 and 15 by reciting the steps of providing one or more advice providers.

As per this limitation, it is noted that Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (Col.1, lines 18-42);

advising said advice consumer of said information if said information meets certain predetermined relevance criteria (Col.3, lines 1-10); and

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said advice provider offering highly targeted advice without compromising individual privacy (Col.5, lines 21-52); and Pant discloses providing a reader resident with said advice consumer that determines relevance of said broadcast information (See Pant, Col.2, lines 25-54; Col.12, lines 41-59).

Thus, it is readily apparent that these prior art systems utilize providing advice providers to perform their specific function.

The remainder of claim 20 is rejected for the same reason given above for claims 1 and 15, and incorporated herein.

(D) Claim 34 differs from claims 1, 15 and 20 by reciting said third party computer including a module for gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers.

As per this limitation, it is noted that Herz discloses a relevance evaluation module to generate queries to said third party consumer database inspector (Col.30, lines 3-67 to Col.31, line 35); and

said third party consumer database inspector including a module for quering said consumer database (Col.32, lines 45-67 to Col.33, line 28);



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means for providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (Col.30, lines 3-67 to Col.31, line 35).

Thus, it is readily apparent that these prior art systems utilize third party computer including a module to perform their specific function.

The remainder of claim 34 is rejected for the same reason given above for claims 1, 15, and 20, and incorporated herein.

4. Claims 2, 16, 21, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164) as applied to claim 1 above, and further in view of Ellesson et al (6,098,099).

(A) As per claims 2, 21, and 35, Herz discloses the system wherein said information of interest to consumers (Col.3, lines 1-10). The combination of Herz and Basche do not explicitly disclose any consumer product warnings, recalls, and safety advisories. However, this feature is known in the art, as evidenced by Ellesson. In particular, Ellesson teaches any consumer product warnings, recalls, and safety advisories (Col.5, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ellesson within the combination of Herz and

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Basche with the motivation of providing a directory database which allows data items or entries stored therein to be marked for third-party notification (Col.3, lines 63-65).

(B) Method claim 16, repeats the subject matter of claim 2 and respectively as a set of “ means- plus-function” elements rather than a series of steps. As underlying processes of claim 16, has been shown to be obvious in view of the collective teachings of Herz and Basche, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitation recited in claims 16 is rejected for the same reasons given above for system claim 2, and incorporated herein.

5. Claims 3-14, 17-19, 22-33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164), Ellesson et al (6,098,099) as applied to claims 1-2 above, and further in view of Tarter et al (5,704,044).

(A) As per claim 3, Herz, Basche and Ellesson disclose the system wherein said consumer product warning (See Ellesson Col.1, lines 13-21). The combination of Herz, Basche and Ellesson do not explicitly disclose information concerning drug products and their interactions. However, this feature is known in the art, as evidenced by Tarter. In particular, Tarter teaches the use of information concerning drug products and their interactions (See Tarter Col.2, lines 27-65).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Tarter within the combination of Herz, Basche and Elleson with the motivation of providing pharmacies with the capability of using their current computer system and their access to the on-line adjudication network to obtain, in some instances overnight payment for insurance claims arising from the provision of healthcare services to their customers (See Tarter Col.9, lines 30-35).

(B) As per claim 4, Tarter discloses the system wherein said third party is a pharmacy (Col.1, line 47); and wherein said advice provider comprises an advice site which operates to notify pharmacies about potentially damaging drug interactions in their customer base (Col.1, lines 32-64).

(C) As per claim 5, Tarter discloses the system wherein any of the FDA and other organizations which may include pharmaceutical manufacturers and consumer organizations, may submit one or more advisories which contain information about interactions and side effects of medications to said advice site (The Examiner interprets health maintenance organization, preferred provider organizations, government agencies, and other entities as a form of the FDA and other organizations which may include pharmaceutical manufacturers and consumer organizations, may submit one or more advisories which contain information about interactions and side effects of medications to said advice site Col.1, lines 19-64).

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(D) As per claim 6, Tarter discloses the system wherein said one or more advisories comprise:

a relevance clause which asserts the existence in a pharmacy database of customers with active prescriptions for drugs having a known, potentially damaging interaction (Col.5, lines 5-37); human readable content which tells about said interaction, tells a pharmacist he has such an interaction in this client base, and urges said pharmacist to correct the situation (Col.5, lines 5-65).

(E) As per claim 7, Tarter discloses the system wherein said advice site collects and posts said submissions (Col.5, lines 5-67).

(F) As per claim 8, Tarter discloses the system wherein one or more pharmacies subscribe to said advice site (Col.5, lines 5-17).

(G) As per claim 9, Tarter discloses the system further comprising :

a pharmacy customer database inspector which is installed on a pharmacy computer for determining if any patients in said pharmacy database have a certain prescription (Col.18, lines 14-67 to Col.19, line 38).

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(H) As per claim 10, Tarter discloses the system wherein said pharmacy computer gathers advisories routinely (Col.19, lines 9-39);

wherein relevance evaluation generates queries to said pharmacy customer database inspector (Col.21, lines 1-56);

wherein said pharmacy customer database inspector queries said pharmacy database (Col.8, lines 41-67); and

wherein relevance messages are provided by said pharmacy to appropriate pharmacy customers for dangerous drug combinations (Col.12, lines 48-67).

(I) As per claim 11, Tarter discloses wherein said advice provider comprises an advice site which operates to notify physicians about potentially damaging drug interactions in their patient base, said system further comprising (Col.1, lines 19-63):

a physician patient database inspector for those physicians who keep track of patient subscriptions on their office computers for determining if any patients in said physician patient database have a certain prescription (Col.1, lines 66-67 to Col.2, line 65). Tarter does not explicitly disclose the system wherein said third party is a physician is obvious. However, it is obvious to include the feature of said third party is a physician within the computerized method and system for financing health care services providers, especially pharmacies of Tartar's with the motivation of providing the means to infuse new cash into the drug distribution system and to allow pharmaceutical

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retailers to purchase inventory or pay down their largest payable obligations more readily (Col.59-62).

(J) As per claim 12, Tarter discloses the system wherein said third party is an individual (Col.1, lines 37-55); and

wherein said advice provider comprises an advice site which operates to notify individuals about potentially damaging drug interactions (Col.1, lines 32-64), said system further comprising :

an individual health record database inspector for those individuals who enter their own subscriptions in a user profile (Col.4, lines 8-67 to Col.5, line 53).

(K) As per claim 13, Tarter discloses the system further comprising :

an information exchange program for allowing a user to query remotely said pharmacy database for information concerning said user (Col.9, lines 29-67).

(L) As per claim 14, Tarter discloses the system wherein said information comprises any of any condition which could be identified by specifying properties which arise singly or in combination in one or more databases, and conditions which, although not explicitly mentioned in said one or more databases, can be inferred to exist with high

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probability based on statistical or other inferences based on information in said one or more databases (Col.35, lines 5-65).

(M) As per claim 17, Tarter discloses the method wherein said third party comprises one or more pharmacies (Col.1, line 47).

(N) Method claims 18-19 repeats the subject matter of claims 3 and 14 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 3 and 14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellessen and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 18-19 are rejected for the same reasons given above for system claims 3 and 14, and incorporated herein.

(O) Claims 22-33 repeat the subject matter of claims 3-14 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 3-14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellessen and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 22-33 are rejected for the same reasons given above for system claims 3-14 and incorporated herein.

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(P) Claims 36-38 repeat the subject matter of claims 17-19 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 17-19 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 35-38 are rejected for the same reasons given above for system claims 17-19 and incorporated herein.

***Response to Arguments***

6. Applicant's arguments filed November 19, 2002 with respect to claims 1 and 20 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is (703)-305-4952. The examiner can be reached on Monday through Thursday from 6:30 to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)-305-9643.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

OR faxed to:

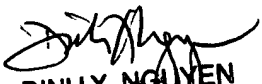
(703) 305-7687 (Official Communications; including  
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"Box AF")

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(703) 746-6065 (Informal / Draft Communications, labeled  
"PROPOSED" or " DRAFT" )

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA., 7<sup>th</sup> Floor (Receptionist).

V.F  
VF/  
July 16, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER